

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

REMARKS

Applicants submit this Response in response to the Office Action mailed April 28, 2005 ("Office Action"). Applicants have amended claims 1, 3, 4, 6, 7, 13, 25, 36, 41, 50, 53-56, 66 and 67, canceled claims 37, 38, 42, 43, 67 and 68 (without prejudice to representing the subject matter of these claims at a later time). Claims 1, 3-4, 6-7, 9-10, 12-13, 15-16, 18-22, 25, 27-33, 36, 39-41, 44-45, 50, 53-56, 59-66 and 69-70 are currently pending. No new matter has been added.

In the Office Action, the Examiner rejected claims 1 and 50 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3-4, 6-7, 9-10, 12-13, 15-16, 18-22, 25, 27-33, 36-45, 50, 53-56, and 59-69¹ under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,727,159 to Kikinis ("Kikinis"); and rejected claim 70 under 35 U.S.C. § 103(a) as being unpatentable over Kikinis. As Applicants have cancelled claims 37, 38, 42, 43, 67 and 68, the rejections as to these claims are moot. Applicants respectfully traverse the rejections of the remaining claims based on the following.²

I. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 1 and 50 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that "it is unclear if the recitations of the 'first network information' on lines 3 and line 5 are referring to the same or different sets of information." Office Action, page 3. Although Applicants do not agree with the Examiner's assertion, to expedite prosecution of this application Applicants have amended claims 1 and 50 to delete the recitation of "the first network information" on line 5 of claims 1 and 50. Accordingly, Applicants respectfully request

¹ At pages 4 and 5 of the Office Action, the Examiner does not list claim 15 as being rejected under 35 U.S.C. § 102(e). However, Applicants believe that since the Examiner did not reject claim 15 under 35 U.S.C. § 103(a), nor indicate the presence of allowable subject matter in claim 15, that the Examiner meant to reject this claim under 35 U.S.C. § 102(e) as well.

² As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 98-3-511-CON RCE1

that the rejection of claims 1 and 50 under 35 U.S.C. § 112, second paragraph, be withdrawn.

II. **Rejection under 35 U.S.C. § 102(e)**

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, (8th ed., 2001).

Applicants address the Examiner's rejections of claims 1, 3-4, 6-7, 9-10, 12-13, 15-16, 18-22, 25, 27-33, 36-45, 50, 53-56, and 59-69 under § 102(e) below.

A. **Claims 1, 7, 13, 25, 50 and 56**

Applicants respectfully submit that Kikinis fails to teach the entirety of claims 1, 7, 13, 25, 50 and 56. For example, Kikinis at least fails to teach "recomposing the second network information to form third network information," such as recited in claims 7 and 25, or a "means for recomposing the second network information to form third network information," such as recited in claims 1 and 13, or a "recomposing device" for "recomposing the second network information to form third network information," as recited in claims 50 and 56. Accordingly, Kikinis cannot anticipate claims 1, 7, 13, 25, 50 and 56.

Kikinis describes a "hand held computer 13" which is connected to a "Proxy Server 19." (Kikinis, col. 4, ll. 17-24.) A user of the hand-held computer can enter a URL for an web site, which is sent to the proxy server. (Id., col. 9, ll. 61-67; Figure 4.) Proxy Server 19 retrieves the HTML page of the requested site and any images associated with the internet page from a web server 23. (Id., col. 10, ll. 9-18.) Proxy Server 19 converts the received images into a format appropriate to the hand-held device, and combines the HTML and converted images into a new single "HTL" file. (Id., col. 10, ll. 19-30.) The HTL file is sent to the hand-held unit 13 and the HTL file is

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

"dumped" to the screen of the hand-held device. (Id., col. 10, ll. 30-33; Figure 4.) Kikinis does not describe any further processing to the HTL file at the hand-held field unit, which is consistent with the description of the HTL file being "dumped" to the screen of the hand-held field unit.

In rejecting claim 1, the Examiner states that "Kikinis teaches ... means for transmitting the second information [at] [fig. 4 #105]." (Office Action, page 4.) At cited Fig. 4, # 105, Kikinis describes sending the created HTL file to the hand-held field unit 13. Accordingly, the Examiner has apparently characterized the created HTL file as the "second network information," as recited in claim 1. However, Kikinis does not describe any further processing to the HTL file at the hand-held field unit. Accordingly, Kikinis fails to teach any "recomposing" of second network information to form third network information, or any means for such recomposing, or any recomposing devices that perform such recomposing.

As Kikinis does not teach or suggest at least the aforementioned elements of claims 1, 7, 13, 25, 50 and 56, Kikinis cannot anticipate these claims. Applicants therefore respectfully request that the rejection of independent claims 1, 7, 13, 25, 50 and 56 under 35 U.S.C. § 102(e) be withdrawn.

Claims 3, 4, and 6 depend from claim 1. Claims 9, 10, and 12 depend from claim 7. Claims 15, 16, and 18-22 depend from claim 13. Claims 27-33 depend from claim 25. Claims 53-55 depend from claim 50. Claims 59-65 depend from claim 56. Since Kikinis fails to teach each and every element of independent claims 1, 7, 13, 25, 50, and 56, that reference also fails to teach each and every element required by the respective dependent claims, and Applicants believe these claims to be patentable over Kikinis for at least the same reasons as the independent claims.³ Accordingly, Applicants respectfully request that the rejection of claims 3, 4, 6, 9, 10, 12, 15, 16, 18-22, 27-33, 53-55, and 59-65 under 35 U.S.C. § 102(e) be withdrawn.

³ As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

B. Claims 36, 41 and 66

Applicants respectfully submit that Kikinis fails to teach or suggest every element of claims 36, 41 and 66. For example, Kikinis at least fails to teach a "means for recomposing the user interface element definition and the network information to form device information, wherein the means for recomposing is separate from the server" as recited in claim 36, or "recomposing at the device using the user interface element definition and the network information to form device information," as recited in claim 41, or a "recomposing device for recomposing using the user interface element definition and the network information to form device information, wherein the recomposing device is separate from the server," as recited in claim 66. Accordingly, Kikinis cannot anticipate claims 36, 41 and 66.

As noted above, Kikinis describes a Proxy Server that converts received images into a format appropriate to the hand-held device, and combines HTML and converted images into a new single "HTL" file for transmission to a hand-held device. Kikinis also describes a hand-held device that receives the HTL file and "dumps" the file to the screen of the hand-held device.

None of the elements of Kikinis read on the claimed elements. For example, in the case of claim 36, if it is assumed that the Proxy Server of Kikinis includes a "means for recomposing" with the functionality as specified in claim 36, it does not also include a "means for receiving a response to the network information request from the server, the response including network information related to the network information request and a user interface element definition related to the network information, the network information and user interface element definitions the result of a translation by the server of retrieved network information responsive to the network information request," as required by claim 36. Furthermore, if it is assumed that the hand-held device described in Kikinis include a "means for receiving" with the functionality recited in claim 36, it does not also include any "means for recomposing" as required by claim 36. Accordingly, Kikinis fails to teach an apparatus having the combination of elements recited in claim 36.

In the case of claim 41, as follows from the discussion above, Kikinis also does not describe a device that both "receiv[es] a response to the network information

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

request from the server, the response including network information related to the network information request and a user interface element definition related to the network information, the network information and user interface element definitions the result of a translation by the server of retrieved network information responsive to the network information request," and "recompose[es] at the device using the user interface element definition and the network information to form device information," as recited in claim 41. Accordingly, Kikinis fails to teach the combination of elements recited in claim 41.

In the case of claim 66, as follows from the discussion above for claim 36, Kikinis also does not describe an apparatus that includes both "a receiver device for receiving a response to the network information request from the server, the response including network information related to the network information request and a user interface element definition related to the network information, the network information and user interface element definition the result of a translation by the server of retrieved network information responsive to the network information request," and "a recomposing device for recomposing using the user interface element definition and the network information to form device information, wherein the recomposing device is separate from the server," as recited in claim 66. Accordingly, Kikinis fails to teach the combination of elements recited in claim 66.

For at least the above reasons, Applicants respectfully submit that Kikinis fails to teach each and every element of independent claims 36, 41 and 66. Accordingly, Applicants respectfully request that the rejections of Independent claims 36, 41 and 66 under 35 U.S.C. § 102(e) be withdrawn.

Claims 39-40 depend from claim 36. Claims 44-45 depend from claim 41. Claim 69 depends from claim 66. Since Kikinis fails to teach each and every element of independent claims 36, 41, and 66, that reference also fails to teach each and every element required by the respective dependent claims. Accordingly, Applicants respectfully request that the rejection of claims 39-40, 44-45 and 69 under 35 U.S.C. § 102(e) be withdrawn as well.

III. Rejection under 35 U.S.C. § 103(a)

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

Regarding the Examiner's rejection of claim 70 under 35 U.S.C. § 103(a), Applicants respectfully disagree with the Examiner's conclusions and assertions as set forth in the Office Action. Accordingly, Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. §2143.03 (8th ed., 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant 's disclosure." See M.P.E.P. § 2143 (8th ed., 2001).

At a minimum, the Examiner cannot establish that the references teach each and every element of Claim 70. Claim 70 depends from claim 66, and requires all of the limitations of claim 66. Since Kikinis, as discussed above, fails to teach each and every element of independent claim 66, that reference also fails to teach or suggest each and every element required by dependent claim 70. Accordingly, Applicants respectfully request that the rejection of claim 70 under 35 U.S.C. § 103(a) be withdrawn.

Furthermore, at page 5 of the Office Action, the Examiner has taken Official Notice "that it is well known to provide video via MPEG over the Internet," and accordingly, "it would have been obvious to one of ordinary skill in [the] art to have conversion for MPEG so as to enable the client device to view the video data." However, when relying on common knowledge, or taking Official Notice, to support a rejection under 35 U.S.C. § 103(a), "the Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test. *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 C.F.R. 1.104(d)(2). If the Examiner maintains this rejection in the future by relying on the position "that it is well known to provide video via MPEG over the Internet," Applicants request that the

U.S. Application No. 09/460,455
Customer No. 32127
Attorney Docket No. 96-3-511-CON RCE1

Examiner provide evidence, either in the form of a reference or affidavit, to support this statement.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the pending claims are in condition for allowance. Reconsideration and allowance are respectfully requested. If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned representative by phone at the number indicated below to discuss such issues. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

Respectfully submitted,

July 29, 2005


Joseph R. Palmieri
Reg. No. 40,760

Verizon Corporate Services Group Inc.
600 Hidden Ridge Drive
Mail Code: HQE03H14
Irving, Texas 75038
(972) 718-4800